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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,145	11/26/2001	Roland Green	700706.90076	8600
7590 11/12/2003				
Nicholas J. Seay Quarles & Brady LLP 1 South Pinckney Street P O Box 2113 Madison, WI 53701-2113			EXAMINER FORMAN, BETTY J	
			ART UNIT 1634	PAPER NUMBER
DATE MAILED: 11/12/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,145	<b>Applicant(s)</b> GREEN ET AL.	
	<b>Examiner</b> BJ Forman	<b>Art Unit</b> 1634	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4 and 7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**FINAL ACTION**

***Status of the Claims***

1. This action is in response to papers filed 5 September 2003 in which claims 1, 4, 7 were amended and claims 2-3, 5-6, 8-9 were canceled. All of the amendments have been thoroughly reviewed and entered.

The previous objections and rejections in the Office Action dated 16 January 2003 are withdrawn in view of the amendments. All of the arguments have been thoroughly reviewed but are deemed moot in view of the amendments, withdrawn rejections and new grounds for rejection.

New grounds for rejection are discussed.

Claims 1, 4 and 7 are under prosecution.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Fiekowsky et al (U.S. Patent No. 6,090,555, issued 18 July 2000).

Regarding Claim 1, Fiekowsky et al disclose a DNA microarray comprising a set of features on a substrate, each of the features including multiple copies of single stranded DNA probes of common sequence (Column 6, lines 7-33) and features including positive control probes being included in the set of features, the positive control probes being arranged in a pattern on the microarray to create a symbol (e.g. circle, square or plus sign) recognizable to a human being when illuminated (Column 7, lines 43-63).

Regarding Claim 4, Fiekowsky et al disclose a method for designing a polynucleotide microarray comprising selecting a set of features, each feature including a plurality of polynucleotide probes of identical sequence (Column 6, lines 7-33) and some of the features including probes designed to serve as positive controls and arranging the set of features on a microarray substrate so that the features containing the positive controls, when illuminated form a symbol (e.g. circle, square or plus sign) recognizable to a human being through visual observation wherein the set of features provides a microarray (Abstract and Column 7, lines 43-63).

Regarding Claim 7, Fiekowsky et al disclose a method for detecting whether an event of interest in a biological experiment has occurred comprising providing a DNA microarray comprising a set of features, each feature including a plurality of single stranded DNA probes (Column 6, lines 7-33), the microarray including features intended to serve as positive controls indicating that an event of interest has occurred, the positive controls being arranged in a pattern forming a character (e.g. circle, square or plus sign) recognizable to a human being through visual observation (Column 7, lines 43-63), hybridizing nucleic acids from a sample to the microarray and observing the presence or absence of the visual pattern to determine if the event of interest (i.e. hybridization) has occurred (Column 6, line 59-Column 7, line 63 and Fig. 6-7).

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Conclusion**

5. No claim is allowed.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (703) 308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 308-8724 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

A handwritten signature in black ink, appearing to be 'BJ Forman', written above the printed name.

BJ Forman, Ph.D.  
Primary Examiner  
Art Unit: 1634  
November 7, 2003